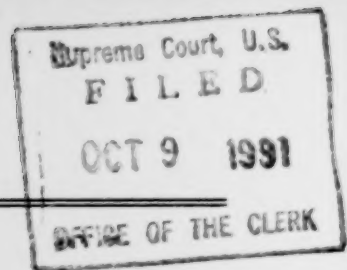


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No. 91-449



In The  
**Supreme Court of the United States**  
October Term, 1991

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STRATAGENE,

*Petitioner,*

v.

WILLIAM D. HUSE and IXSYS, INC.,

*Respondents.*

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On Petition For A Writ Of Certiorari To The United  
States Court Of Appeals For The Federal Circuit

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**RESPONDENTS' BRIEF IN OPPOSITION**

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## QUESTION PRESENTED

Where the Federal Circuit has, at petitioner's insistence, considered and decided all issues in an appeal from the district court's dismissal of a complaint alleging purported patent and antitrust claims, is the court obligated to grant petitioner's request for a post-judgment transfer of the antitrust claim to another circuit for a second appellate review if it affirms the district court's decision that the alleged patent issues are not ripe for review?

## **PARTIES TO THE PROCEEDING**

The parties are identified in the caption. Respondent Ixsys, Inc. has no parent company or subsidiaries.

## TABLE OF CONTENTS

	Page
QUESTION PRESENTED .....	i
PARTIES TO THE PROCEEDING .....	ii
STATEMENT OF THE CASE.....	1
SUMMARY OF REASONS WHY CERTIORARI SHOULD BE DENIED.....	3
REASONS WHY CERTIORARI SHOULD BE DENIED .....	4
CONCLUSION .....	8

## TABLE OF AUTHORITIES

Page

## CASES

<i>Christianson v. Colt Industries Operating Corp.</i> , 486 U.S. 800 (1988) .....	6, 7
<i>Hargrove v. U.S.</i> , 1 Cl. Ct. 228 (Cl. Ct. 1982).....	5
<i>Squillacote v. U.S.</i> , 747 F.2d 432 (7th Cir. 1984), cert. denied, 471 U.S. 1016 (1985) .....	6
<i>Westside Property Owners v. Schlesinger</i> , 597 F.2d 1214 (9th Cir. 1979).....	5

## STATUTES AND CODES

Title 28, United States Code	
Section 1295(a)(1) .....	2, 4
Section 1338(a) .....	2, 4, 5
Section 1631 .....	4
Title 35, United States Code	
Section 111 .....	2
Section 116 .....	2

## RULES AND REGULATIONS

Federal Circuit Rules	
Rule 36. ....	3
Rule 36(e) .....	3

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STATEMENT OF THE CASE

The Petition for Certiorari omits significant aspects of the factual and procedural background of this case. In 1989, after resigning from his position at petitioner Stratagene, respondent Dr. Huse conceived of a novel approach to the production of antibodies and similar molecules. Petitioner nevertheless asserted a claim to Dr. Huse's invention under an agreement that Dr. Huse had entered while he was in petitioner's employ requiring him to assign his rights to ideas conceived during his employment with Stratagene.

In 1990, petitioner instituted this action claiming ownership of Dr. Huse's invention and asserting that

respondents had committed an "antitrust" violation in connection with an assignment agreement that they had entered with a third party for development of the invention. In an amended complaint, petitioner sought declaration of inventorship and of date of invention under the patent laws of the United States, 35 U.S.C. §§ 111, 116. The district court dismissed these claims on the ground that, until a patent had issued, petitioner's claims for a declaration of joint inventorship and date of invention were not ripe for review and petitioner's remedy, if any, was before the patent office. Pet. App., pp. D 20-D 22. The court dismissed petitioner's antitrust claim for failure to state a claim for relief because no injury to competition had been alleged. *Id.* The court pointed out that Stratagene had knowledge of the invention, and that, because no patent had issued, "any member of the public," including petitioner, was free to practice the invention. *Id.* at D 21.

Petitioner appealed the dismissal of its complaint to the United States Court of Appeals for the Federal Circuit. Respondents moved to dismiss the appeal on the ground that the case involved a dispute over ownership of Dr. Huse's idea, which arose under state contract law rather than the federal patent laws. Petitioner opposed dismissal on the ground that its claims for a declaration of joint inventorship and date of invention "arise solely under the patent laws in that they assert a right or interest under the patent laws," and thus supported jurisdiction in the court of appeals under 28 U.S.C. §§ 1338(a) and 1295(a)(1). Response by Appellant Stratagene to Motion of Appellees Huse and Ixsys to Dismiss for Lack of Jurisdiction, p. 6 (Oct. 29, 1990). On November 16,

1990, the court of appeals denied the motion to dismiss. The entire case, including both the viability of petitioner's claims for a declaration of joint inventorship and date of invention and its antitrust claim, was then fully briefed, heard, and decided by the merits panel.

On May 17, 1991, the court of appeals summarily affirmed the district court's dismissal of the action without opinion pursuant to Circuit Rule 36, which provides for such an affirmance where "a judgment or decision has been entered without an error of law; and an opinion would have no precedential value." Fed. Cir. Rules, Rule 36(e). After receipt of this adverse decision, petitioner filed a petition for rehearing, claiming that the Federal Circuit was instead required to transfer the case to the Ninth Circuit for decision of its antitrust claim. On June 12, 1991, the court of appeals denied rehearing, and on September 9, 1991, it declined petitioner's suggestion for rehearing *en banc*.

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#### SUMMARY OF REASONS WHY CERTIORARI SHOULD BE DENIED

The question posed by the petition is not presented by this case. Petitioner successfully opposed dismissal of its appeal by the Federal Circuit for lack of jurisdiction on the ground that its claims for declaration of inventorship and date of invention did arise under the patent laws. The Federal Circuit's decision affirming rather than dismissing petitioner's appeal indicates that that court determined that those claims, while they had been properly dismissed by the district court because they were not

ripe for review, did fall within the jurisdiction of the Federal Circuit under 28 U.S.C. §§ 1338(a) and 1295(a)(1). Moreover, even if that court had ultimately concluded that the claims at issue did not arise under the patent laws, it was not obligated to transfer petitioner's antitrust claim to the Ninth Circuit for a second appellate review. 28 U.S.C. § 1631 provides for transfer only if the court of appeals determines that would be "in the interest of justice." In this case, petitioner's attempt at forum shopping would not have been in the interest of justice, and the Federal Circuit's determination of this fact-specific question presents no issue worthy of this Court's attention.

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#### REASONS WHY CERTIORARI SHOULD BE DENIED

The petition for certiorari does not raise any claim of error (let alone error of such importance as would warrant the grant of certiorari by this Court) in the district court's dismissal of petitioner's complaint. Rather, petitioner claims that the court of appeals' summary affirmation of that decision was erroneous because, having ultimately upheld the district court's conclusion that petitioner had no presently ripe claim for a judicial declaration of joint inventorship or date of invention with respect to a patent that had not yet issued, that court was obligated to transfer the case to the United States Court of Appeals for the Ninth Circuit. Pet., pp. 3, 6-7.

That contention is incorrect. The plain language of 28 U.S.C. § 1631 requires the transfer of an appeal *only* if the court of appeals determines both that it lacks jurisdiction

over the appeal and that such a transfer would be "in the interest of justice." In this case, neither condition is satisfied. While petitioner asserts that the Federal Circuit accepted respondents' contention that the case did not arise under the patent laws (Pet., p. 3), that court's decision affirming rather than dismissing petitioner's appeal indicates that it ultimately concluded that petitioner's claims seeking a declaration of joint inventorship and date of invention, although properly dismissed because they were not ripe for review, did fall within the jurisdiction of that Court under 28 U.S.C. §§ 1338(a) and 1295(a)(1). Moreover, even if a reviewing court determines that it lacks jurisdiction over an appeal, it has discretion to refuse a transfer when it concludes that a transfer would not serve the interest of justice. See, e.g., *Hargrove v. U.S.*, 1 Cl. Ct. 228 (Cl. Ct. 1982) (court properly refused to transfer case after granting motion to dismiss appeal for want of jurisdiction); cf. *Westside Property Owners v. Schlesinger*, 597 F.2d 1214, 1220 (9th Cir. 1979) (transfer not required even where claims would be barred by statute of limitations). Contrary to petitioner's contention (Pet., p. 3), there is no conflict of decision on this issue.

As the court of appeals correctly concluded, the interests of justice would not have been served by transferring petitioner's purported antitrust claim to the Ninth Circuit in this case. Respondents promptly brought the question of jurisdiction before the court of appeals by their motion to dismiss the appeal. Petitioner, however, vigorously opposed that motion on the ground that its claims for declaration of joint inventorship and date of invention arose under the patent laws and the entire case

should be decided by the Federal Circuit. Petitioner's position prevailed. As a result, it succeeded in keeping the entire appeal before the Federal Circuit for decision, and both parties devoted considerable time and effort to fully briefing the antitrust issues that petitioner, after receipt of an adverse decision, now asserts should be transferred to the Ninth Circuit for duplicative review. To require the transfer of this case at this juncture would contravene Congress' clearly expressed intent when it created the Federal Circuit:

The Committee is concerned that the exclusive jurisdiction over patent claims of the new Federal Circuit not be manipulated. \* \* \* It is not intended to create forum shopping opportunities between the Federal Circuit and the regional courts of appeals on other claims.

*See Squillacote v. U.S.*, 747 F.2d 432, 435 (7th Cir. 1984), cert. denied, 471 U.S. 1016 (1985) (quoting Senate Report; petition for rehearing and rehearing *en banc* denied; government's request to transfer case to the Federal Circuit denied). Having sought a decision on the merits and lost, petitioner's request for transfer amounts to the very type of forum shopping that Congress condemned.

Petitioner's contention that the Federal Circuit was required to transfer this case by this Court's decision in *Christianson v. Colt Industries Operating Corp.*, 486 U.S. 800 (1988) is incorrect. As noted above, unlike *Christianson*, the Federal Circuit in this case rejected respondents' motion to dismiss the appeal for lack of jurisdiction. Further, *Christianson* did not hold that transfer is mandated in all cases in which the Federal Circuit, after full hearing, ultimately determines that a case does not arise

under the patent laws. To the contrary, this Court specifically reaffirmed that transfer is mandated only when the court of appeals determines that it is "in the interest of justice." *Id.* at 818, quoting 28 U.S.C. § 1631. In *Christianson*, this Court remanded the case to be transferred to the Seventh Circuit *only* because the Federal Circuit had previously determined – in a ruling that had become law of the case – that transfer was appropriate under the much different circumstances present in that case. This Court explained that the courts of appeals should adhere "strictly to principles of law of the case" in cases involving controverted issues of transfer. *Id.* at 819. To do otherwise "would undermine public confidence in our judiciary, squander private and public resources, and commit far too much of this Court's calendar to the resolution of fact-specific jurisdictional disputes that lack national importance." *Id.* at 818-819. In this case, in contrast to *Christianson*, the Federal Circuit has properly concluded that transfer is *not* appropriate, and there is no occasion for this Court to issue certiorari to review its decision of this "fact specific jurisdictional dispute" that presents no question of general importance.

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## CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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